

REMARKS-General

1. The current amended independent claim 19 and the newly drafted independent claim 26 incorporate all structural limitations of the original claim 1 and include further limitations previously brought forth in the disclosure. No new matter has been included. All new claims 19-30 are submitted to be of sufficient clarity and detail to enable a person of average skill in the art to make and use the instant invention, so as to be pursuant to 35 USC 112.

2. With regard to the rejection of record based on prior art, Applicant will advance arguments to illustrate the manner in which the invention defined by the newly introduced claims is patentably distinguishable from the prior art of record. Reconsideration of the present application is requested.

Response to Rejection of Claims 19-25 under 35USC103

3. The Examiner rejected claims 19-25 under 35USC103(a) as being unpatentable over Yamamoto (JP2003-109547) in view of Kling (US 6,175,197) and further in view of Borowiec (EP646941 A1). Pursuant to 35 U.S.C. 103:

“(a) A patent may not be obtained though the invention is **not identically** disclosed or described as set forth in **section 102 of this title**, if the **differences** between the subject matter sought to be patented and the prior art are such that the **subject matter as a whole would have been obvious** at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

4. In view of 35 U.S.C. 103(a), it is apparent that to be qualified as a prior art under 35USC103(a), the prior art must be cited under 35USC102(a)~(g) but the disclosure of the prior art and the invention are not identical and there are one or more differences between the subject matter sought to be patented and the prior art. In addition, such differences between the subject matter sought to be patented **as a whole** and the prior art are obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

5. In other words, the differences between the subject matter sought to be patent as a whole of the instant invention and Yamamoto which is qualified as prior art of the instant invention under 35USC102(b) are obvious in view of Kling and Borowiec at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

6. The applicant respectfully submits that Yamamoto is not sufficient to be qualified as a cited art. First, Yamamoto is in Japanese, which is a foreign language to the applicant. Second, only a translation of the Abstract of Yamamoto is provided in English which makes it impossible to understand the document as a whole. Third, the Abstract of Yamamoto has clearly indicated the object of invention is to provide an electrodeless discharge lamp in which light control of the electrodeless discharge lamp can be made without increasing power loss at the core, which cannot be directly link to the present invention in any sense. Fourth, the drawings only indicate different arrangements of the cores (2a, 2b, 2c) in relation to the discharge loops (6a, 6b, 6c) and hence Yamamoto is best to understand as light control through the position of the cores with respect to the discharge loops, which is not related to the present invention in any sense. Fifth, Yamamoto is a patent publication which is not comprehensible for rejection under 35USC103(a), especially when the Supreme Court has held that prior references MUST BE CONSIDERED AS A WHOLE, but is relied upon by the examiner for rejection under 35USC103(a).

7. The applicant respectfully submits that the differences between the instant invention and Yamamoto are not obvious in view of Kling and Boroweic under 35USC103(a), due to the following reasons.

8. Regarding claim 19, Yamamoto fails to teach a magnetic light comprising an air-filled light body which has an inner cavity, and a fluorescent layer coated onto said inner cavity of the light body. Yamamoto is silent as to the provision of a fluorescent layer, at least in the Abstract which is the only portion understandable by the applicant. In addition, Yamamoto also fails to teach a coating of fluorescent layer which is capable of illumination throughout the entire inner surface of the light body.

9. The applicant re-submits that Yamamoto fails to teach a magnetic body positioned in the through slot of the inner cavity, and is arranged to generate high

frequency resonance toward **the fluorescent layer**, wherein the fluorescent layer, after the high frequency resonance, is then arranged to generate illumination having an enhanced luminous efficiency, extended life span and enhanced energy saving ability. The element identified by the examiner (2a) in Yamamoto is expressly disclosed to be a core. It is not by itself magnetic body.

10. In addition, Yamamoto is silent as to the presence of high frequency resonance or the fluorescent layer. That is to say, Yamamoto fails to teach the magnetic body, the high frequency resonance and the fluorescent layer of the instant invention directly or indirectly. Therefore, Yamamoto also fails to teach the arrangement and relations between the magnetic body, the high frequency resonance and the fluorescent layer of the instant invention.

11. Yamamoto fails to teach a magnetic light, comprising an air-filled light body which **comprises a glass tube** and an **air guiding tube**, and has an inner cavity, wherein **the glass tube is extended into the inner cavity**, and is communicated with the inner cavity for storing a predetermined amount of mercury. The examiner acknowledges the absence of the glass tube and the air guiding tube.

12. In view of the above, the applicant submits that Yamamoto is insufficient to establish a prima facie case of rejection under 35USC103(a).

13. The examiner acknowledges the absence of the glass tube and the air guiding tube and refers to Kling as a teaching of these features. The applicant resubmits that Kling merely teaches an electric lamp assembly comprising: an electrodeless lamp including an electrodeless lamp envelope enclosing a fill material for supporting a low pressure discharge, the electrodeless lamp further including an amalgam located within the lamp envelope; a transformer core disposed in proximity to the lamp envelope; an input winding disposed on the transformer core for receiving radio frequency energy from a radio frequency source, the radio frequency energy producing the low pressure discharge in the lamp envelope; and a thermal connection comprising a heat-conducting material disposed between the transformer core and the amalgam, wherein the amalgam is heated by the transformer core during operation.

14. In addition to the previous submission in relation to Kling, which showed that Kling is different from the instant invention, the applicant further submits that the

major concern in Kling is about the low pressure discharge in which temperature is a limitation. The fact that Kling makes use of radio frequency, amalgam, transformer core and input wiring indicates that Kling is different in structure when compared with the instant invention. The fact that Kling makes use of thermal connection and heat-conducting material to control temperature indicates that Kling is different in configuration and in principle when compared to the instant invention.

15. In particular, the applicant re-submits that Kling merely discloses the exhaust tabulation 72 in the presence of the amalgam to provide a thermal bridge, while the transformation core and the exhaust tabulation should be in a relatively close proximity. This restriction substantially discourages one having mere ordinary skill in the art to take out parts of Kling invention, as what the examiner does, to combine these elements with other inventions. Nothing in Yamamoto and Kling motivate, suggest or teach the combinations of the elements as identified by the examiner.

16. The applicant respectfully submits that when a particular element is expressly disclosed that it must work with certain other elements, it is not obvious for one having no inventive capacity to take that element and combine it with some other elements to achieve different result. Such a combination would constitute an unobvious invention which should have pass the statutory muster under 35USC103(a). The applicant respectfully reminds the examiner that 35USC103(a) DOES NOT prohibit combination, but just obvious combination.

17. The applicant respectfully submits that the patentable subject matter of the instant invention is not only the physical components identified by the examiner, but also the particular configuration of the various components and their relationship. In the instant invention, there is no disclosure as to the particular configuration recited in claim 19. The applicant is of the view that the examiner fails to consider the particular configuration of the magnetic light of the instant invention as a whole.

18. The applicant respectfully submits that "The mere fact that a reference could be modified to produce the patented invention would not make the modification obvious unless it is suggested by the prior art." *Libbey-Owens-Ford v. BOC Group*, 4 USPQ 2d 1097, 1103 (DCNJ 1987). In the instant invention, nothing in Yamamoto and

Kling suggest the particular configuration of the magnetic light of the instant invention. In fact, the combination is merely a speculative imagination of the examiner.

19. While it is permissible to modify a reference's disclosure in the examination of patent applications, such modifications are not allowed if they are prompted by an applicant's disclosure, rather than by a reasoned analysis of the prior art and by suggestions provided therein. *In re Lesilie*, 192 USPQ 427 (CCPA 1977). In hindsight, the Examiner may feel that it would be obvious to combine the cited references to produce the instant invention. Such hindsight reconstruction **is not a permissible** method of constructing a rejection under 35 U.S.C. 103. *In re Warner and Warner*, 154 USPQ 173, 178 (CCPA 1967). The examiner argues that any obviousness assessment necessarily involves hindsight reconstruction. However, the examiner also acknowledges that hindsight reconstruction is only allowed to the extent that it is within the level of ordinary skill and does not include knowledge gleaned from applicant's disclosure. In the instant invention, the particular configuration is actually gleaned from the applicant's disclosure. The rule cited by the examiner DOES NOT APPLY.

20. The examiner also refers to Borowiec (US EP 646941) as a teaching of the glass tube for storing a predetermined amount of mercury. The applicant resubmits that the patentable subject matter of Borowiec's invention is its distinctive configuration of the SEF lamp. As a result, when the examiner takes out one component from Borowiec and combines it with the disclosure contained in Yamamoto to come up with a completely different configuration of the magnetic light, it is hard to see why such a completely new configuration is devoid of any inventive steps. The Court of Appeal of the Federal Circuit has stated, "[V]irtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983). Thus, **"[t]he cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."** *In re Fine*, 5 USPQ 2d 1600 (Fed. Cir. 1988).

21. Regarding claim 26, in addition to the above argument, Yamamoto fails to teach an air-filled light body having an inner cavity and at least a through slot defined on said inner cavity, which comprises a glass tube provided on said light body and extended into said inner cavity to communicate with said inner cavity, and an air guiding

tube provided on said light body for filling and discharging a gas into and from said inner cavity of said light body; a predetermined amount of mercury stored in said glass tube; a fluorescent layer coated onto said inner cavity; and a magnetic body penetrated through said through slot of said inner cavity into position, is arranged to generate high frequency resonance such that illumination having an enhanced luminous efficiency, extended life span and enhanced energy saving ability is generated through said fluorescent layer in said inner cavity of said light body.

22. In particulars, Yamamoto fails to the particular elements and configuration of magnetic body in relation to the light body, the air guiding tube, the glass tube and the coating of fluorescent layer.

The Cited but Non-Applied References

23. The cited but not relied upon references have been studied and are greatly appreciated, but are deemed to be less relevant than the relied upon references.

24. In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of the rejection are requested. Allowance of claims 19-30 at an early date is solicited.

25. Should the examiner believe that anything further is needed in order to place the application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

/Raymond Y. Chan/

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